

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

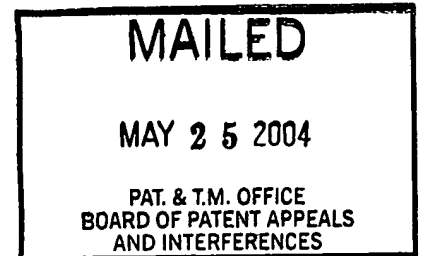
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY E. GEBHARD

Appeal No. 2004-1187
Application No. 09/328,749

ON BRIEF



Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner for appropriate action with regard to the items indicated below.

On October 23, 2003 appellant filed a reply brief (Paper No. 31). The reply brief includes 20 pages of argument and comments concerning each of the four prior art rejections maintained by the examiner and separately addressing the examiner's various

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positions with regard to nearly all of the twenty-three claims on appeal. In addition, appellant attacks the examiner's rejection methodology generally, urging that the examiner has failed to provide adequate justification of a suggestion to combine or modify the cited references, and that the examiner's approach constitutes classic hindsight reconstruction. In response to the reply brief, the examiner sent out Paper No. 32 (mailed November 18, 2003) informing appellant that the reply brief had been "entered and considered" and that the application was being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Our problem is that the examiner's *pro forma* response is woefully inadequate in this case and has not provided us with his views concerning the numerous and specific arguments presented by appellant in the reply brief. Thus, we REMAND the application to the examiner for a response on the record to the many arguments and issues raised by appellant in the reply brief.

In reviewing the examiner's answer (Paper No. 30, mailed August 19, 2003), we also note that the examiner has continued to reject claim 6 under 35 U.S.C. § 103(a) notwithstanding that

appellant's brief (at page 4), under the heading "STATUS OF CLAIMS," specifically indicates that claim 6 is "not being appealed." We REMAND for clarification, noting that it appears the examiner should have dismissed the appeal with regard to claim 6.

As a further issue on REMAND, we solicit the examiner's views on whether or not the entirety of the intermediate sole member (e.g., 101) in Anderie '631 can be considered to be a "torsion system" like that defined in appellant's claims 1 and 26 on appeal and whether such a "torsion system" would anticipate at least claims 1 and 26. In that regard, using claim 26 on appeal as an example, we note that the sports shoe bottom described in Anderie (Figs. 9-10) appears to include an outer wearing sole (102) having a forefoot area and a rearfoot area, as well as a "torsion system" comprising the entirety of the intermediate sole member (101) and including a forefoot portion spanning the forefoot area of the outsole, the forefoot portion having a generally smooth concave contour along the longitudinal axis of the outsole and torsion system (Fig. 10); a rearfoot portion spanning the rearfoot area of the outsole; and an intermediate portion (including central limb 108 and stiffening element 109)

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coupling the forefoot portion and the rearfoot portion of the torsion system, and constructed of a material and configured to allow, in a pre-selected manner, rotation of the forefoot portion relative to the rearfoot portion about the longitudinal axis, wherein the intermediate portion includes a rib (e.g., 114, 115) that projects beyond an adjacent surface (e.g., 113 or 119) of the tension system. Contrary to appellant's arguments in the brief and reply brief, it appears that the language of claims 1 and 26 on appeal with regard to the rib projecting "beyond an adjacent surface of the torsion system" (emphasis added) does not require the rib to project beyond all surfaces of the torsion system, as appellant seems to believe, but only requires that the rib project beyond some "adjacent surface" of the torsion system.

A supplemental examiner's answer fully responsive to the reply brief and clarifying the other issue noted above would appear to be necessary and is authorized, if appropriate. It follows that appellant should have an opportunity to respond to any such supplemental answer by way of a further reply brief. Note, for example, 37 CFR § 1.193(b)(1) and (b)(2).

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MEMORANDUM

TO: GROUP TC-3728 DIRECTOR

FROM: BOARD OF PATENT APPEALS AND
INTERFERENCES

SUBJECT: ORDER REMANDING TO EXAMINER

We are forwarding this application to
your Group for taking further action
consistent with the decision of the Board
remanding this appeal to the Primary Examiner.

Program & Resource Administrator
Board of Patent Appeals and Interferences
308-9797

SERIAL NUMBER <div style="font-size: 1.5em; font-family: cursive;">09/328749</div>	U.S. DEPARTMENT OF COMMERCE PATENT OFFICE	DATE OF MEMORANDUM <div style="font-size: 1.5em; font-family: cursive;">5/25/2004</div>
APPLICATION FILING DATE <div style="font-size: 1.5em; font-family: cursive;">6/9/99</div>	APPEAL NUMBER <div style="font-size: 1.5em; font-family: cursive;">2004-1187</div>	
FORM PO-262 (9-69)		
EXAMINER'S DISPOSITION OF APPEAL		
To: Clerk, Board of Appeals	From: Group Art Unit _____	
GROUP: Please detach and forward to Board of Appeals promptly, but ONLY if the appeal is suspended or no longer pending.		
The Examiner has: <ul style="list-style-type: none"> <input type="checkbox"/> 1. Withdrawn the final rejection and <ul style="list-style-type: none"> <input type="checkbox"/> a. allowed all the claims <input type="checkbox"/> b. made a new rejection and reopened the prosecution <input type="checkbox"/> c. other <input type="checkbox"/> 2. Maintained the final rejection, but has <ul style="list-style-type: none"> <input type="checkbox"/> a. instituted an interference which cannot proceed concurrently with the appeal (Note M.P.E.P. 1205) <input type="checkbox"/> b. other <input type="checkbox"/> 3. The application is now abandoned. 		
_____ (Date signed)	_____ (Signed)	